

REMARKS

Claims 15-17 are pending. By this Amendment, claims 15-17 are amended to make express the inherent scope and meaning of “correlated” as “statistically correlated.” No narrowing amendment is intended by this amendment. Support for this amendment can be found throughout the specification and no new matter is added.

Claim 15 is amended to clarify the inherent and intended scope of the “fast pre-screen” as “a short subset of a larger in-depth assessment, the short subset being selected to ~~serve as a fast~~ present a job-related pre-screen that can be presented at the terminals faster than presenting all questions in the larger in-depth assessment.” Support for this amendment can be found throughout the specification and no new matter is added.

Claim Rejections Based on the Brooks Presentation

Claims 15 and 16 continue to be rejected under 35 U.S.C. 102(a) as being anticipated by the presentation by Paul W. Brooks entitled “Internet Assessment: Opportunities and Challenges.” Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over the presentation by Paul W. Brooks entitled “Internet Assessment: Opportunities and Challenges” in further view of Ogden, U.S. Pat. No. 6,311,164. These rejections are respectfully traversed based on the fact that the Brooks presentation is not proper prior art.

It is respectfully submitted that the position taken in the Office Action that the §1.132 affidavit by the inventor, Katrina Dewar, was insufficient to swear behind the date of the Brooks presentation is both contrary to the MPEP and to the law under the circumstances of the present application. The Examiner’s attention is directed to the portion of MPEP 2132.01 stating that it is permissible to overcome a rejection by submitting “a 37 CFR 1.132 affidavit to show derivation of the reference subject matter from applicant and invention by applicant. *In re Facius*, 408 F.2d 1396, 161 USPQ 294 (CCPA 1969).”

Specifically, the present application is factually similar to *In re Katz*, 687 F.2d 450, 215 USPQ 15 (CCPA 1982) where there was no evidence of any inventorship dispute. The citation in the Office Action to the portion of MPEP 2132.01 that states “if there is evidence that the co-author has refused to disclaim inventorship and believes himself or herself to be an inventor, applicant’s affidavit will not be enough to establish that applicant is the sole inventor and the rejection will stand” does not represent the facts in the present application. As noted in the Office Action, the Brooks presentation is not a publication involving joint authors and there is no evidence in the record of Mr. Brooks believing himself to be an inventor. As such, the facts and circumstances of the present application are unlike the facts of *Ex parte Kroger*, 219 USPQ 370 (Bd. Pat. App. & Inter. 1982), the case that is referenced in the cited portion of MPEP 2132.01 in which there was a refusal to execute an affidavit and an allegation by the refusing party that he was an inventor. The declaration of Mr. Dewar establishes that the work of Mr. Brooks was done while he was an employee of ePredix, Inc., the previous assignee of the present application, and that Mr. Brooks is not an inventor. Consequently, there is no evidence in this case “that the co-author has refused to disclaim inventorship.” Accordingly, it is respectfully requested that the rejections based on the Brooks presentation be withdrawn.

Claim Rejections Based on the “StoreWorks” Document

Claims 15 and 16 continue to be rejected as being anticipated under 35 U.S.C. 102(b) by Decision Point Data, Inc. “1999 StoreWorks! Conference and Exhibition,” hereinafter “the StoreWorks Document.” Claim 17 continue to be rejected under 35 U.S.C. 103(a) as being unpatentable over the StoreWorks Document in further view of Ogden U.S. 6,311,164. These rejections are respectfully traversed.

In response to the arguments that the StoreWorks document lacks a publication date, it is asserted in the Office Action that the StoreWorks conference & Exhibition was held on May 16-

19, 1999, citing to Appendix A to the Office Action, which is a web archive printout of what is purportedly a “Calendar of Events” for 1999 from www.nrf.com/events. It is respectfully submitted that this evidence is facially insufficient to establish a *prima facie* case of the date of the StoreWorks document for a number of reasons.

First, there is nothing in Appendix A which is entitled “StoreWorks”. As such, there is no evidence of any date of the 1999 conference in terms of which of the several NRF conferences held at various times in 1999 might be the correct conference, even assuming that the StoreWorks conference was an NRF conference.

Second, the use of evidence based on a Wayback Machine archive link is not valid evidence of publication of a 102(b) reference as of a specified date.

“[T]he information posted on the Wayback Machine is only as valid as the third-party donating the page decides to make it--the authorized owners and managers of the archived websites play no role in ensuring that the material posted in the Wayback Machine accurately represents what was posted on their official websites at the relevant time.”

Novak v. Tucows, Inc., 2007 WL 922306, *5 (E.D.N.Y. March 26, 2007).

Third, the assertion in email communications between the Applicant’s attorney and the Examiner (see Attachment A) that a web archive link for the www.nrf.com.events site in the following year, 2000, establishes the date of the StoreWorks Document is also flawed. The assumption that a conference date in one year is somehow related to a conference date in another year when those conferences have different titles is simply unsupported and cannot satisfy the burden of proof on the Examiner to show a specified publication date for a reference being used as the basis for a proper rejection. Because the web site is for the National Retail Federation, it is respectfully submitted that all of the conferences concern retail topics.

Fourth, even if there were some evidence of the specified date of a given conference title in 1999, there is still no evidence that the particular materials relied upon in the 102(b) rejection were, in fact, presented at that conference.

Finally, even assuming that the materials were presented at the conference at the purported date in May 1999, there still must be an analysis as to whether a presentation of the materials at a conference constitutes a printed publication for purposes of 102(b) and no such analysis has been made.

"The determination of whether a reference is a "printed publication" under 35 U.S.C. § 102(b) involves a case-by-case inquiry into the facts and circumstances surrounding the reference's disclosure to members of the public. *In re Cronyn*, 890 F.2d at 1161; *In re Hall*, 781 F.2d at 899. Accordingly, our analysis must begin with the facts of this case, none of which are in dispute.

In this case, the Liu reference was displayed to the public approximately two years before the '950 application filing date. The reference was shown to a wide variety of viewers, a large subsection of whom possessed ordinary skill in the art of cereal chemistry and agriculture. Furthermore, the reference was prominently displayed for approximately three cumulative days at AACC and the AES at Kansas State University. The reference was shown with no stated expectation that the information would not be copied or reproduced by those viewing it. Finally, no copies of the Liu display were distributed to the public and the display was not later indexed in any database, catalog or library.

Given that the Liu reference was never distributed to the public and was never indexed, we must consider several factors relevant to the facts of this case before determining whether or not it was sufficiently publicly accessible in order to be considered a "printed publication" under § 102(b). These factors aid in resolving whether or not a temporarily displayed reference that was neither distributed nor indexed was nonetheless made sufficiently publicly accessible to count as a "printed publication" under § 102(b). The factors relevant to the facts of this case are: the length of time the display was exhibited, the expertise of the target audience, the existence (or lack thereof) of reasonable expectations that the material displayed would not be copied, and the simplicity or ease with which the material displayed could have been copied. Only after considering and balancing these factors can we determine whether or not the Liu reference was sufficiently publicly accessible to be a "printed publication" under § 102(b)."

In re Klopfenstein, 380 F.3d 1345, 1350 (Fed. Cir. 2004).

For all of these reasons, it is respectfully submitted that the StoreWorks document has not been established as proper 102(b) prior art.

Even *assuming arguendo* that the StoreWorks document were proper prior art, which it is not, Applicant continues to assert that the StoreWorks document fails to fully disclose, describe, or enable the claimed invention as required under §102(b) for a document to serve as prior art. The Office Action points to the lack of reference to “statistically validated” in the claim. Claims 15-17 have been amended to clarify that the correlation referenced by the claimed invention is “statistically correlated.” Contrary to the arguments made in the Office Action, standardizing questions across a company does not teach or suggest preparing a set of validated questions that are statistically correlated to job performance ratings with previous responses.

With respect to the arguments made on the top of page 5 of the Office Action, it is respectfully submitted that these arguments either (a) impermissibly use the hindsight afforded by the present invention, or (b) the logic for the arguments is conjecture, circular and not supportable. The statement that the order of a list of “Interactive Interview Follow-On Questions” identified as “In order of Importance” on page 5 of the StoreWorks document somehow “shows that high ranked questions are more likely to result in hiring quality employee from past experience” is not understandable as a reasoned basis for demonstrating the claimed limitations are present in the reference. The statement that “the questions must be made from past experience” is mere unsupported conjecture by the Examiner.

With respect to the arguments made at the bottom of page 5 and top of page 6 of the Office Action, it is respectfully submitted that the amendment to claim 15 to clarify the nature of the “short subset” address this concern and that there is nothing which teaches or suggests this limitation in the StoreWorks document. To the extent that the arguments made by the Examiner are understood, it is asserted that there is nothing but the mere conjecture of the Examiner that

there is an initial set of questions (as compared to filing in background facts/qualifications listed on a job application) given to any job applicants in the description of the system in the StoreWorks document.

Finally, it is noted that the limitation as to the short subset is a limitation specific to independent claim 15 and that this portion of the Office Action does not address the responses previously submitted with respect to the patentability of independent claims 16 and 17, even assuming that the StoreWorks document is a proper 102(b) prior art reference, which it is not.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Brad Pedersen', with a long horizontal flourish extending to the right.

Brad Pedersen
Registration No. 32,432

Customer No. 24113
Patterson, Thunte, Skaar & Christensen, P.A.
4800 IDS Center
80 South 8th Street
Minneapolis, Minnesota 55402-2100
Telephone: (612) 349-5774